REMARKS

In response to the final Office Action of October 17, 2006, Applicants have amended the claims, which when considered with the following remarks, is deemed to place the present application in condition for allowance. Favorable consideration and allowance of all pending claims is respectfully requested. The amendments to the claims have been made in the interest of expediting prosecution of this case. Applicants reserve the right to prosecute the same or similar subject matter in this or another application.

Claims 1-30 are pending in this application. By this Amendment, Claims 1 and 20 have been amended and new Claims 31 and 32 have been added. Claims 1 and 20 have been amended to more particularly point out the invention, by specifying that the plurality of different lubricating oil compositions is at least 20. Support for amended Claims 1 and 20 and new Claims 31 and 32 can be found throughout the specification, e.g., page 4, lines 1-8 and page 23, lines 1-11. Applicants respectfully submit that no new matter has been added to this application. Moreover, it is believed that the amendment to the claims as presented herein places the application in condition for allowance or in better form for consideration on appeal, if one becomes necessary.

In the last Office Action mailed October 17, 2006, the Examiner provisionally rejected Claims 10 and 22-23 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over copending U.S. Application No. 10/699,510. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

In the last Office Action mailed October 17, 2006, the Examiner provisionally rejected Claims 20 and 22-30 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over copending U.S. Application No. 10/699,507. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

In the last Office Action mailed October 17, 2006, the Examiner provisionally rejected Claims 20, 22-24 and 26-30 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over copending U.S. Application No. 10/699,508. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

In the last Office Action mailed October 17, 2006, the Examiner provisionally rejected Claims 1 and 17-18 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over copending U.S. Application No. 10/779,422. Upon resolution of all outstanding issues remaining in the Office Action, Applicants will consider the timely submission of a Terminal Disclaimer.

In the last Office Action mailed October 17, 2006, the Examiner rejected Claims 1-3, 8-11 and 16-19 under 35 U.S.C. §102(e) as being anticipated by Carey et al. U.S. Publication No. 2004/0144355 ("Carey et al.").

Carey et al. disclose a marine diesel engine system containing a slow-speed cross head marine diesel engine with at least one cylinder; and cylinder lubricant components proximate to the engine and containing (a) a primary lubricant and (b) an additive selected from (i) an alkylamine-alkylphosphate having at least 1.25 equivalents of alkylamine to 1.0 equivalents of

alkylphosphate, (ii) 500 TBN calcium sulfonate, and (iii) mixtures thereof. Carey et al. further disclose in Example 2 storage stability data for six different lubricating oil compositions. As set forth in Table II in Carey et al. the six different lubricating oil compositions each contain the same base oil and either (1) no additive (Comparative Example 2); (2) calcium sulfonate as the additive in varying amounts (Example 2 and Comparative Examples 3 and 4); (3) magnesium sulfonate as the additive (Comparative Example 5) or (4) calcium phenate as the additive (Comparative Example 6).

In contrast to the presently claimed invention, Carey et al. fail to disclose or suggest a combinatorial lubricating oil composition library comprising "a plurality of different lubricating oil compositions comprising (a) a major amount of at least one base oil of lubricating viscosity and (b) a minor amount of at least one lubricating oil additive, wherein the plurality of different lubricating oil compositions is at least 20" as presently recited in amended Claim 1. Thus, the presently recited combinatorial library, as set forth in the present claims, contains at least 20 lubricating oil compositions including different base oils each of varying types and/or amounts and different lubricating oil additives also each of varying types and/or amounts. Carey et al. on the other hand simply disclose storage stability data for six different lubricating oil compositions as set forth in Table II therein, one of which does not even contain an additive. As Carey et al. do not disclose all of the elements and limitations of the claimed invention, unquestionably, then, the presently claimed combinatorial lubricating oil composition library recites novel subject matter over Carey et al.

For the foregoing reasons, amended Claims 1-3, 8-11, 16-19 and new Claim 31 are believed to be patentably distinct over Carey et al. and withdrawal of the rejection under 35 U.S.C. §102(e) is respectfully requested.

In the last Office Action mailed October 17, 2006, the Examiner rejected Claims 1-2, 8-10 and 16-26 under 35 U.S.C. §102(e) as being anticipated by Kolosov et al. U.S. Publication No. 2004/0123650 ("Kolosov et al."). This rejection is respectfully traversed.

Kolosov et al. nowhere disclose or suggest a combinatorial lubricating oil composition library comprising, *inter alia*, "a plurality of different lubricating oil compositions comprising (a) *a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive*" as presently recited in amended Claim 1. Nor, for that matter, does Kolosov et al. disclose or suggest a high throughput method for producing a combinatorial lubricating oil composition library, under program control, comprising, *inter alia*, (a) providing a library of a plurality of different lubricating oil composition samples comprising (i) *a major amount of at least one base oil of lubricating viscosity and (ii) a minor amount of at least one lubricating oil additive*, each sample being in a respective one of a plurality of test receptacles; (b) measuring lubricating oil composition properties of each sample to provide lubricating oil composition property data for each sample; and, (c) outputting the results of step (b) as presently recited in amended Claim 20.

According to the Examiner in the Advisory Action mailed February 6, 2007, "Kolosov teaches that any flowable commercial product may be screened or tested in the combinatorial library, and lubricating oil compositions used in the automotive/marine industry containing a major amount of a base oil and a minor amount of an additive are known commercially available

flowable products. Kolosov also teaches that exemplary flowable materials that can be screened in the library include lubricants, and these lubricants can be in different material forms including oils. See paragraph nos. 0042 and 0043 in Kolosov. Therefore, commercial lubricating oil compositions containing a major amount of a base oil and a minor amount of an additive used in the automotive/marine industry are encompassed by the teaching of Kolosov since Kolosov discloses that lubricant commercial products in the form of oils and additives therein can be evaluated or screened using the combinatorial library set forth."

This wholly unsupported basis cannot possibly serve as a basis for this rejection. It is well established that, for a claim to be anticipated, a single prior art reference must disclose each and every element of the claimed invention, *either expressly or inherently. Lewmar Marine, Inc. v. Barient, Inc.*, 827 F.2d 744, 747, 3 USPQ2d 1766, (Fed. Cir. 1987); *cert. denied*, 484 U.S. 1007 (1988). Firstly, Kolosov et al. disclose in paragraph 0042 that *most* any flowable material that may be a commercial product itself or may be an ingredient or portion within a commercial product can be screened or tested and then goes on to disclose a genera of material samples, one of which may be a lubricant. Secondly, a lubricant can be a grease, jelly, e.g., K-Y jelly, as well as powders, e.g., dry graphite, PTFE, etc., formulated with water and can be used as is such that all lubricants may not even require an additive or, for that matter, be used in a lubricating oil composition. Finally, a lubricating oil composition can be a concentrate that contains a major amount of a lubricating oil additive and a minor amount of base oil of lubricating viscosity as a diluent for the concentrate. Certainly, then, a commercial lubricating oil composition may not even contain a major amount of a base oil and a minor amount of an additive as alleged by the Examiner. Thus, at no point does Kolosov et al. provide any disclosure that a lubricant can even

be a base oil of lubricating viscosity for use in a lubricating oil composition much less a plurality of different lubricating oil composition samples comprising (a) a major amount of at least one base oil of lubricating viscosity and (b) a minor amount of least one lubricating oil additive as presently recited in amended Claims 1 and 20. Thus, Kolosov et al. do not disclose all of the elements and limitations of the claimed invention. Accordingly, amended Claims 1, 2, 8-10 and 16-26 and new Claims 31 and 32 clearly possess novel subject matter relative to Kolosov et al. and withdrawal of the rejection under 35 U.S.C. §102(e) is respectfully requested.

In the last Office Action mailed October 17, 2006, the Examiner rejected Claims 4-7 and 12-15 under 35 U.S.C. §103(a) as being obvious over Carey et al.

The foregoing deficiencies of Carey et al. discussed above with respect to the rejection of Claim 1, from which Claims 4-7 and 12-15 ultimately depend, apply with equal force to this rejection. At no point is there any suggestion, motivation or even a hint in Carey et al. of providing a combinatorial lubricating oil composition library comprising "a plurality of different lubricating oil compositions comprising (a) a major amount of at least one base oil of lubricating viscosity and (b) a minor amount of at least one lubricating oil additive, wherein the plurality of different lubricating oil compositions is at least 20" as presently recited in amended Claim 1, from which Claims 4-7 and 12-15 ultimately depend.

Instead, Carey et al. merely disclose a lubricating component for marine diesel engines which includes a marine diesel engine lubricant as the primary lubricant and an additive such as a detergent, an antioxidant, a dispersant, a demulsifier, a defoamant or an antiwear additive. Moreover, there must be some teaching or suggestion within the reference, or within the general knowledge of one skilled in the art, to arrive at the claimed invention. If it is the Examiner's

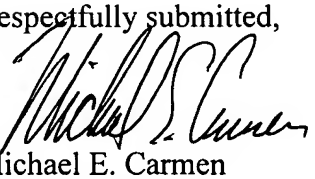
position that Carey et al. teach or suggest the claimed combinatorial lubricating oil composition library, the Examiner is respectfully requested to provide with particularity (i.e., by column and line) where in Carey et al. such suggestion and motivation can be found. Certainly, nothing in Carey et al. would lead one skilled in the art to modify the lubricating component for marine diesel engines disclosed therein and arrive at the presently recited combinatorial lubricating oil composition library. Accordingly, Claims 4-7 and 12-15 are believed to be nonobvious, and therefore patentable, over Carey et al. and withdrawal of the rejection under 35 U.S.C. §103(a) is respectfully requested.

In the last Office Action mailed October 17, 2006, the Examiner rejected Claims 27-30 under 35 U.S.C. §103(a) as being unpatentable over Kolosov et al. in view of Smrcka et al., European Patent No. 1233361 ("Smrcka et al.").

The foregoing deficiencies of Kolosov et al. discussed above with respect to the rejection of Claim 20, from which Claims 27-30 ultimately depend, apply with equal force to this rejection. Smrcka et al. do not cure and is not cited as curing the above-noted deficiencies of Kolosov et al. Rather, Smrcka et al. is merely cited for its disclosure of storing test results in a data carrier. Accordingly, Claims 27-30 are believed to be nonobvious, and therefore patentable, over Kolosov et al. and Smrcka et al.

For the foregoing reasons, amended Claims 1-30 and new Claims 31 and 32 as presented herein are believed to be in condition for allowance. Such early and favorable action is earnestly solicited.

Respectfully submitted,



Michael E. Carmen
Reg. No. 43,533
Attorney for Applicants

M. CARMEN & ASSOCIATES, PLLC
170 Old Country Road – Suite 400
Mineola, NY 11501
Phone: (516) 992-1848
Facsimile: (516) 739-0981
MEC